

U.S. Patent Application Serial No. 10/820,345
Amendment Under 37 C.F.R. § 1.116 dated February 6, 2007
Reply to Final Office Action of December 8, 2006

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REMARKS

Claims 1-5 are amended. New claims 14 and 15 are presented. The amendments and new claims are supported by the application as originally filed. No new matter is added.

Amendments to claims 1-5 deletes the term "composition" to eliminate possible ambiguity. The invention of claims 1-5 relates to a pigment having a surface treatment, and not to a composition, e.g. a paint, that includes a pigment. New claims 14 and 15 further characterize the surface treatment of claims 1 and 9.

Claims 1-13 are rejected under 35 U.S.C. §102(b) as being anticipated by Yamauchi et al. (US 3,988,288). Applicants traverse the rejection to the extent that it can be maintained.

The invention as now claimed clearly relates to a pigment per se as defined by claim 1 and further characterized by dependent claims 2-4. US '288 discloses a powder paint composition comprising a polyester compound and a polyepoxide compound. US '288 also discloses generic ingredients that may be present including pigments (column 6 lines 42-49). However, US '288 does not disclose a species of pigment having a surface treatment as claimed. Applicants respectfully submit that the generic disclosure of pigments in US '288 does not direct one of ordinary skill to the species of pigment claimed and therefore, does not anticipate claim 1.

Claim 1 is also amended to recite that the reaction of an epoxy compound with pigment particles is in the presence of a solvent. The powder paint composition '288 excludes solvents and therefore does not anticipate claim 1 or claims depending therefrom.

Claim 5 and dependent claims 6-8 relate to a pigment dispersion comprising a pigment having a surface treatment as described and claimed. For the reasons stated above, US '288 does not anticipate the claimed pigment and therefore fails to teach all of the elements of claims 5-8. Also, examples using pigment particles having a surface treatment and comparative examples using untreated pigment particles show that even in the presence of a dispersant, Disperbyk 163 (a high molecular weight polyurethane dispersant), pigments according to the invention provide significant and unexpected reduction in viscosity of pigment dispersions. Applicants respectfully submit that claims 5-8 are not anticipated by US '288.

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Claim 9 and claims 10-13 that depend therefrom relate to a method of making pigments, i.e. surface treating particles, according to the invention. Claim 9 recites a reaction of an epoxy compound with pigment particles. Applicants respectfully submit that US '288 fails to disclose a reaction of pigment particles with an epoxy compound and therefore does not anticipate claims 9-13.

Applicants respectfully submit that claims 1-13 and new claims 14-15 are not anticipated by Yamauchi et al. (US 3,988,288) and request that the rejection be withdrawn.

Claims 1-13 are rejected under 35 U.S.C. §102(b) as being anticipated by Ohnishi (US 5,747,599). Applicants traverse the rejection to the extent that it can be maintained.

US '599, like US '288, discloses coating compositions, i.e. paint. Although US '599 discloses pigments, it does not disclose the species of pigment claimed by the Applicants. As explained above, the generic disclosure of pigments does not direct one of ordinary skill to the species of pigment claimed. As shown by the examples and comparative examples, the surface treatment provides a significant, non-trivial improvement with respect to the viscosity and thixotropic index over pigments not having the claimed treatment (examples 1-5 and comparative examples).

Independent claims 5 and 9 and claims depending from claim 5 or 9 relate to a method of making the claimed pigment or to a composition including the claimed pigment. Since US '599 does not anticipate the claimed pigment, Applicants respectfully submit that US '599 does not anticipate claims relating to making the claimed pigment or to compositions that use it.

Applicants respectfully submit that claims 1-13 and new claims 14-15 are not anticipated by Ohnishi (US 5,747,599) and request that the rejection be withdrawn.

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In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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Date:

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